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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,169	01/12/2001	Ursula Murschall	00/002 MFE	2792
7590	02/24/2004		EXAMINER	
ProPat, L.L.C. 2912 Crosby Road Charlotte, NC 28211			UHLIR, NIKOLAS J	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/760,169

Applicant(s)

MURSCHALL ET AL. 

Examiner

Nikolas J. Uhler

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-11.

Claim(s) withdrawn from consideration: 13-18.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of boxes 2(a)(c)

The proposed amendment will not be entered because it raises a new issue that requires further search and consideration to determine patentability. Specifically, the requirement that the transparent, low flammability, UV resistant, oriented film be biaxially oriented was not earlier presented and requires further search and consideration to determine patentability.


Continuation of box 5(c): The applicant's request for reconsideration has been considered but do not place the case in condition for allowance. The applicants arguments with respect to the biaxial orientation of the film are drawn to the limitation in the non-entered amendment and thus are moot.

Regarding the applicants argument as to there being no motivation to combine the cited references in the manner proposed by the examiner. The examiner respectfully disagrees. Oishi teaches adding Dimethyl methylphosphonate (DMMP) to a polyethylene terephthalate film for the purpose of improving flame resistance. Thus, given that Murschall teaches the use of a polyethylene terpethalate film, the examiner maintains that one of ordinary skill would have been motivated to utilize DMMP as taught by Oishi in the PET film taught by Murschall. Regarding the combination of Murschall and Oishi with Rakos, Given that Murschall and Oishi are directed towards PET films and that Rakos specifically teaches utilizing an adhesion layer to improve the adhesion of a PET film to a substrate, the examiner maintains that one of ordinary skill in the art at the time the invention was made would have been motivated to make the

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modification as proposed by the examiner. Finally, with respect to the combination of Murschall and Oishi with Schreck and Kishida, given that Murschall and Oishi are directed to PET films and the fact that Schreck and Kishida teach incorporating alkali metal stearates and phenolic stabilizers to PET films to control discoloration and heat deterioration at high temperatures, the examiner maintains that one of ordinary skill in the art at the time the invention was made would have been motivated to make the modification as proposed by the examiner.

The crux of the applicants arguments appears to be an argument of unexpected results. Specifically, applicants in the proposed after final amendment or in other amendments have argued that the yellowness of the fillm, the clarity of the film, and other properties are unexpected. However, applicants have provided no data to prove such. For example, the applicants have argued on the record that the yellowness of biaxially oriented films increases as result of the film being scorched when it is heated and stretched. While the examiner acknowledges this to be true, the examiner notes that the Murshcall reference teaches that the yellowness of the unoriented film is  $\leq 5$ . Though the film may be increased in yellowness through biaxially orientation, there is no evidence showing that an increase of yellowness from 5 to above 10 is unexpected. The applicant has presented similar arguments with respect to the flame retardency, the U.V. resistance, and other properties of the film, but has presented no conclusive data to establish these results as unexpected.

  
Paul Thibodeau  
Supervisory Patent Examiner  
Technical Center 1700